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IN THE

Supreme Court of the United States

OCTOBER TERM, 1959

No. 428

COLUMBIA BOILER CO., INC., *Petitioner*,

v.

MANVILLE BOILER CO., INC., *Respondent*.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

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Petitioner, the defendant-appellee below, respectfully prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Fourth Circuit entered in the above-entitled action on July 25, 1959.

OPINIONS BELOW

The opinion of the Court of Appeals for the Fourth Circuit is reported at 122 USPQ 545 and appears as Appendix A to this Petition. The District Court did not hand down an opinion, but made findings of fact and conclusions of law, which appear as Appendix B to this Petition.

JURISDICTION

The judgment of the Court of Appeals was entered on July 25, 1959. The jurisdiction of this Court is invoked under 28 U. S. C. Sec. 1254(1).

QUESTIONS PRESENTED

(1) Was it not error, in view of the express condition of the Patent Act of 1952 that a patent may *not* be obtained if the differences between the alleged invention and the prior art are such that the subject matter as a whole *would be obvious* to a person having ordinary skill in the art, for the Court below to adopt a more liberal standard of invention than that established by decisions of this Court prior to that Act?

(2) Was it not error for the Court below, in conflict with the rulings of various other Circuits, to apply more liberal rules as to invention than those established by decisions of this Court prior to the Patent Act of 1952?

STATUTE INVOLVED

Section 103 of the Patent Act of 1952, 66 Stat. 792-814, 35 U. S. C. Sec. 1-293, which is involved here, is printed in Appendix C to this Petition.

STATEMENT OF THE CASE

Respondent brought this suit against petitioner for infringement of U. S. Patent No. 2,633,107 issued March 31, 1953 to B. W. Mandelburg (see Plaintiff-Appellant's Appendix, p. 82).

The subject matter of the alleged invention had to do with the substitution of a round rather than oval smoke outlet or flue on a domestic hot water heating boiler.

Obviously, there was nothing either new or inventive about a round outlet pipe, but in the particular type of boiler involved petitioner had used an oval smoke outlet and the substitution of a round outlet required some internal rearrangement of the boiler construction.[1]

There was substantial undisputed testimony that there were a number of simple ways available to accommodate the round outlet pipe.[2] The one used by petitioner was adopted by a welding foreman,[3] who simply used an arrangement similar to what petitioner had used for many years in other types of boilers.[4]

District Judge Hutcheson held the claim in suit fully anticipated by these other boilers, also invalid over prior art, and finally not infringed (see Plaintiff-Appellant's Appendix, pp. 120-123). The Court of Appeals, without express reference to these findings, took a diametrically opposite view and held the claim in suit both valid and infringed.

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[1] The best that the Court of Appeals could say was that this change was "desirable" to avoid "difficulty and expense" in the installation of boilers with oval outlets, but their avoidance could not be "classified as a major contribution to the heating industry" (Appendix A, p. 5a). The fact was that any gain from the avoidance of these minor disadvantages was more than offset by the increased danger of pressure drop (Appellee's Appendix, pp. 38a-39a) and petitioner was reluctant to make the change for this reason.

[2] For testimony to this effect, see Plaintiff-Appellant's Appendix, pp. 58, 98-100, 102.

[3] Plaintiff-Appellant's Appendix, p. 69.

[4] Defendant-Appellee's Appendix, pp. 31-33.

REASONS FOR GRANTING THE WRIT

(1) The Decision of the Court of Appeals Is Based on a Standard of Invention Derived From an Interpretation of the Patent Act of 1952 Which This Court Has Not Sanctioned and Which Conflicts With Prior Decisions of This Court.

Ever since the Patent Act of 1952 was enacted, there has been uncertainty and confusion in judicial decisions and professional opinions as to the effect of Section 103, or as to the lack of it, on the strict standard of invention established by the decisions of this Court prior to the Act. There has been no occasion for this Court to speak on the interpretation of the Section, or as to the standard of invention, since the Act was passed, and nothing less than an authoritative interpretation by this Court will resolve the doubt and restore much needed stability.

Indicative of the urgency of the need is the fact that at least two other petitions involving this question are currently pending before the Court as this is written. In *Bernard Glagovsky* v. *Bowcraft Trimming Co. et al.*, No. 369, this Court is asked to review a decision of the First Circuit Court of Appeals which is to the diametrically opposite effect from the decision of the Fourth Circuit Court of Appeals referred to above. In *Stoffel Seals Corporation* v. *E. J. Brooks Company*, No. 361, the majority opinion of the Second Circuit Court of Appeals was in line with that of the First Circuit in the Glagovsky case; the dissenting opinion was in line with that of the Fourth Circuit in the present case.

The Applicable Standard of Invention Prior to 1952

In *Hotchkiss* v. *Greenwood*, 52 U. S. 248, 266-267 (1851), this Court set forth the requirement for patent-

ability that there must be a result of ingenuity and skill more than that "possessed by an ordinary mechanic acquainted with the business". Almost the same language is used in the Patent Act of 1952—a patent may not be granted for subject matter that would have been obvious "to a person having ordinary skill in the art".

The above language has had different meanings at different times. Two of the latest interpretations by this Court are found in *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84 (1941) and *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147 (1950). In the *Cuno case*, the Court summarized the cases beginning with *Hotchkiss* v. *Greenwood* as meaning that the new device must "reveal the flash of creative genius, not merely the skill of the calling". Ingenuity is not enough; there must be something "more than that to be expected of a mechanic skilled in the art". In the later *A. & P. case*, the lower Courts were admonished to "scrutinize combination patent claims with care" to make sure they meet the "rather severe test" of producing "unusual or surprising consequences from the unification of the elements" concerned.

Judged by the above tests, the decision of the Fourth Circuit Court of Appeals is plainly defective in that "a standard of invention appears to have been used that is less exacting than that required where a combination is made up entirely of old components" (*A. & P. case*, *supra*, p. 154).

The 1952 Act Did Not Change the Standard of Invention

Until the decision of the Second Circuit Court of Appeals in *Lyon* v. *Bausch & Lomb Optical Co.*, 224 F. 2d 530 (1955), there was general agreement that the Act of 1952 merely codified the existing decisional law as to standard of invention.[1] The standard of the *Cuno* and *A. & P. cases* continued to be applied.

Beginning with the *Lyon case* in 1955, however, the view has gained acceptance that Section 103, although essentially the same in language as *Hotchkiss* v. *Greenwood*, was nevertheless intended to and did destroy the standard of invention as developed through the *Cuno* and *A. & P. cases* and to require a "return" to some less strict standard not yet defined by this Court.[2] The Fourth Circuit Court of Appeals has followed suit, referring in *Brown et al.* v. *Brock et al.*, 240 F. 2d 723, to the "accepted tests" of the standard of invention "as recently explained in *Lyon* v. *Bausch & Lomb*".

But even Judge Learned Hand was not sure of his position in the *Lyon case*. As he later said before a Senate committee, it "remains to be seen" whether the Court was right and "I hope the case will go up".[3]

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[1] H.R. Rep. No. 1923, 82nd Cong., 2d Sess., p. 7, stated expressly that Section 103 "paraphrases language which has often been used in decisions of the courts, and the section has been added to the statute for uniformity and definiteness". Nothing suggested any change of standard.

[2] Reference is often made to a "return" from the standard of the Cuno and A. & P. cases to that of Hotchkiss v. Greenwood, an obvious impossibility since these cases apply the same standard as noted in the Cuno case.

[3] Hearings before the Subcommittee on Patents, Trademarks and Copyrights of the Committee on the Judiciary, United States Senate, 84th Cong., 1st Sess., pursuant to S. Res. 92 on the American Patent System, Oct. 11, 1955, pp. 119-120.

Since the *Lyon case*, the decisions have only added to the confusion. Petitioner submits that an authoritative consideration and interpretation of Section 103 by this Court is urgently needed.

(2) The Decision of the Court of Appeals Is Based on a Standard of Invention Different From and Conflicting With the Standards in Other Circuits.

In the absence of an authoritative ruling by this Court on the effect of Section 103, the Patent Act of 1952 has signally failed to accomplish one of the hoped-for objectives of Congress. As stated in the reports of the Judiciary Committees of both the Senate and the House, which accompanied the bill when it was presented and adopted, one of the "major changes" was the incorporation of "a requirement for invention in Sec. 103", which it was thought "should have a stabilizing effect and minimize great departures."[1]

Instead the new section has created confusion between the various Circuits by reason of the change that some, but not all, assume it to have worked in the rules previously established by the decisions of this Court as to the standard of invention required for patentability.

Some Circuits Follow the Lyon Decision in the Second Circuit

In June, 1955, Judges Learned Hand, Swan and Hincks handed down the decision of the Second Circuit Court of Appeals in the *Lyon case* mentioned above. As previously indicated (footnote [3], p. 6), Judge Hand apparently was in doubt as to the accuracy of the Court's view that the intent of Con-

[1] H.R. Rep. No. 1923, 82nd Cong., 2d Sess., pp. 5 and 7; S. Rep. No. 1979, 82nd Cong., 2d Sess., pp. 4 and 6.

gress in passing the new Act had been to change the rules as to the standard of invention, and as pointed out below there is still disagreement between the Judges of the Second Circuit Court of Appeals. Nevertheless Judge Hand's opinion has found favor and has been followed in a number of other Circuits.

The Third Circuit has liberally construed the Patent Act and specifically adopted the reasoning and holding of the *Lyon case*. In *R. M. Palmer Co.* v. *Ludeh's, Inc.*, 236 F. 2d 496, 498, 500, 501 (1956), six of the seven sitting judges affirmed the validity of certain design patents for simple objects, relying upon the statutory presumption of validity and accepting the argument that the Patent Act constituted "a congressional change of direction to assertedly more lenient criteria" than the previous rigid standard for determining validity. The Court said that it was inclined to accept the "sensitive observations of Judge Learned Hand" in the *Lyon case*. The *Palmer case* was followed by the Third Circuit in *Plax Corp.* v. *Precision Extruders, Inc.*, 239 F. 2d 792, 794-795 (1957), and *Fisch* v. *Gould*, 246 F. 2d 5, 7-8 (1957), cert. denied, 355 U.S. 914 (1958).

The Fourth Circuit Court of Appeals similarly has relaxed the rigid requirements for invention, following the *Lyon case*. In *Brown* v. *Brock*, 240 F. 2d 723, 726-728 (1957), the Court upheld a patent on a weeping doll, concluding that "The patent involved here certainly meets the standard of invention by the accepted tests, as recently explained in [the *Lyon case*]." And in *Otto* v. *Koppers Co.*, 246 F. 2d 789, 799-801 (1957), cert. denied, 355 U. S. 939 (1958), the same Court, holding that the factors of commercial success and long un-

successful attempts overcame the defense of obviousness, and, relying on the *Lyon case* and the statutory presumption of validity, reversed a judgment of invalidity.

The Court of Appeals for the District of Columbia, in *L-O-F Glass Fibers Co.* v. *Watson*, 228 F. 2d 40, 47 (1955), reversed a denial of a patent application and specifically adopted and followed the teaching of the Lyon case, saying:

> "* * * We may safely assume that the Patent Act of 1952, 35 U.S.C.A. Sec. 103 was intended to restore 'the law to what it was when the Court announced the definition of invention.' See discussion by Judge Learned Hand in Lyon v. Bausch & Lomb Optical Co. * * *."

The decision of the Fourth Circuit Court of Appeals in the present case, while it does not mention the *Lyon case* by name, is another instance of the application of the theory of the *Lyon case*, now well established in the Fourth Circuit.

Meanwhile, however, disagreement has made itself felt between the judges of the Second Circuit itself, as indicated by the division of the Court in *E. J. Brooks Co.* v. *Stoffel Seals Corp.*, 266 F. 2d 841. The situation is thoroughly discussed in the pending petition (No. 361) of Stoffel Seals Corp. for a writ of certiorari.

Other Circuits Continue to Follow the Rules As to Standard of Invention Established by Decisions of This Court Prior to the Patent Act of 1952

The view of the Circuits in this category is well illustrated by the following statement by the Eighth Circuit Court of Appeals in *Steffan* v. *Weber Heating and Sheet Metal Company*, 237 F. 2d 601, 604 (1956):

> "Plaintiffs contend that the Patent Act of 1952, and particularly 35 U.S.C. Sec. 103, has liberalized the test of invention to be applied. See Lyon v. Bausch & Lomb Optical Co., 2 Cir., 224 F. 2d 530. The effect, if any, of section 103 upon standards to be applied in determining validity of patents has not been passed upon by the Supreme Court."

The First and Ninth Circuits adhere to the same view. In the Ninth Circuit, in *Oriental Foods* v. *Chun King Sales*, 244 F. 2d 909 (1957), the Court first quoted Section 103, and then pointed out that the standard of invention was written into the Constitution and proceeded to apply Section 103 in the light of the *A. & P. case*.

In the First Circuit case of *Wasserman* v. *Burgess & Blacher*, 217 F. 2d 402 (1954), the Court stated that the Patent Act of 1952 "merely codified the existing decisional law." Subsequently, the *Lyon case* was called to the attention of the Court in *Hawley Products Co.* v. *United States Trunk Co.*, 259 F. 2d 69 (1958), but the Court did not find it necessary specifically to reject the *Lyon case* since the patents were invalid anyway. The later case of *Bernard Glagovsky* v. *Bowcroft Trimming Co.*, 267 F. 2d 479 (1959) is now pending before this Court on a petition by Glagovsky (No. 369) for a writ of certiorari. In this decision the Court of Appeals refused to review its finding in the Wasserman case, holding again that the patent was invalid even when judged by a liberal standard of invention.

This hopeless conflict of opinion and decision between the various Circuits can only be resolved by an authoritative decision from this Court as to the Congressional intent in passing the new act, and specifically as to the effect of Section No. 103 on the standard of invention.

CONCLUSION

Petitioner submits that this basic issue in an important branch of Federal law, i.e., the meaning and effect of the statutory requirement for patentable invention, should no longer be left to doubt but should be resolved once and for all by this Court, to provide the stabilization desired and intended by Congress, and to put an end to "forum shopping", and promote uniformity of decision throughout the various Circuits.

For each and all of the above reasons, this petition should be granted.

Respectfully submitted,

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APPENDIX A

Opinion of the Court of Appeals

(Filed July 25, 1959)

UNITED STATES COURT OF APPEALS
FOR THE FOURTH CIRCUIT

No. 7768

MANVILLE BOILER COMPANY, INCORPORATED, *Appellant*,

v.

COLUMBIA BOILER COMPANY OF POTTSTOWN, INCORPORATED, and COLUMBIA BOILER COMPANY, INCORPORATED, *Appellees*.

Appeal from the United States District Court for the Eastern District of Virginia, at Richmond.

Sterling Hutcheson, District Judge

(Argued January 16, 1959. Decided July 25, 1959)

Before Sobeloff, Chief Judge, Haynsworth, Circuit Judge, and Boreman, District Judge.

Stanton T. Lawrence, Jr. (Richard H. Catlett, Jr., and Christian, Barton, Parker & Boyd on brief) for Appellant, and Zachary T. Wobensmith, 2nd, (Wirt P. Marks, Jr. on brief) for Appellees.

HAYNSWORTH, Circuit Judge:

This is a patent case involving the usual defenses of invalidity and noninfringement. Upon proof that was largely documentary or undisputed, the District Judge was persuaded that both defenses were meritorious and he filed appropriate findings of fact and conclusions of law. We take a different view.

The patent involved, Mandelburg No. 2,663,107 issued in 1953, covers a modification of the Stauffer design for domestic boilers so as to permit the use of a circular rather than an oval stack outlet and to provide a variable,

automatic damper permitting flue gases to be drawn off through the stack without passing around the uppermost water baffle when the internal boiler pressures are excessive.

In 1938 Stauffer Patent No. 2,119,606 was issued covering a design of a boiler, which is illustrated by the figure in the margin.[1] In boilers of this design, water is circulated between inner and outer shells of the boiler. Integral with the inner shell are four water containing baffles so disposed that flue gases rising from the combustion chamber follow a serpentine pattern around and over the baffles before being discharged through the stack. Each of these baffles is connected to each side of the inner shell of the boiler, so that there is a water connection at each side of each baffle as well as a water connection at the rear of the baffle. Above the topmost gas passage and the stack outlet, there is another space for water, or for water containing elements, to provide domestic hot water. The efficiency of the Stauffer boiler is influenced by the size and proportion of the flue gas passages. If the uppermost passage is unduly large, a loss of efficiency is experienced, and Stauffer's design, for domestic boilers, did not provide sufficient vertical space for a circular stack outlet eight inches in diameter. To provide a stack outlet of sufficient cross-sectional dimension, therefore, an oval shaped stack outlet was provided. Since the chimneys in substantially every home are equipped with circular flues, adapters were required to connect the oval stack outlet of the boiler to the circular flue of the chimney. The testimony indicates that the oval shaped outlet is somewhat more efficient than the circular shaped outlet, for it is a less radical departure from the shape of the uppermost gas passage, but the use of adapters to accommodate the oval opening to the circular chimney flue was expensive and troublesome.

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[1] Here reproduce Figure 4 of Stauffer Patent No. 2,119,606.

The predecessor of Columbia Boiler Co. of Pottstown, Inc. (Columbia) in 1936 began the manufacture of domestic boilers of the Stauffer design. A witness, who had served Columbia as plant manager, testified that during the period 1936-1941 Columbia had attempted to modify the Stauffer design so as to permit the use of a circular stack outlet. These attempts were directed to enlargement and modification of the space above the topmost baffle to give greater vertical height to the stack outlet without lowering its lower edge. Columbia's experimental modifications of the design to permit the use of a circular stack outlet resulted in such a decrease in efficiency, however, that they were not adopted. Apparently, it did not realize that its purpose might be achieved by altering the baffle, the lower boundary of the limited space, rather than the upper boundary, and Columbia continued to use the oval stack outlet until 1953, when, after issuance of the Mandelburg Patent, Columbia modified its design in accordance with the teaching of the patent.[2] After commencement of this suit, it made a slight further modification in this design, but it has equipped its boilers with circular stack outlets since 1953.

Benedict W. Mandelburg controlled Columbia Boiler Sales Co. of New York, which from 1939 to 1948 was a principal sales outlet for Columbia, purchasing and reselling boilers manufactured by Columbia of the tubeless Stauffer design as well as tubular boilers for residential use. This association was severed in 1948, and in 1951 Mandelburg applied for a patent upon what he claimed to be a substantial improvement in the Stauffer design.

Mandelburg undertook to provide space for a circular stack outlet by disconnecting the uppermost wet baffle

[2] Witnesses for Columbia testified this was done without actual knowledge of the patent. A mistake in the manufacture of one boiler, they said, led them to the independent discovery of Mandelburg's improvement.

from the inner shell of the boiler at the rear, leaving the water connections at the side unaffected. The rear of this baffle was cut off and sealed so as to provide a space between the rear of the baffle and the inner shell, permitting the lowering of the bottom of the stack opening to a position approximating the level of the bottom of the uppermost wet baffle, or even lower. To direct the flue gases around and over the uppermost wet baffle, he interposed a dry baffle connecting the lower rear edge of the uppermost wet baffle to the inner shell of the boiler at a point below the new stack opening. He further disclosed that this dry baffle might be equipped with an automatic damper, permitting flue gases to pass directly to the stack after completing the second passage when internal pressures were excessive. Insofar as it is relevant to our inquiry, what he did is illustrated by a figure in the margin.[3]

Claim 1 of the Mandelburg Patent is in the following language:

> "1. A boiler construction comprising inner and outer shells spaced apart to provide a water space therebetween, said inner shell having substantially horizontally-extending, water-carrying heating sections vertically spaced from one another and interconnected through said water space, said heating sections being arranged to provide for the normal serpentine flow of heating gases around and between the heating sections, a cylindrical integral stack outlet structure extending between the inner and outer shells and lying in an elevated location adjacent the uppermost heating section and bridging spaces lying above and below the uppermost heating section, and transversely-extending, downwardly and rearwardly inclined baffle means in the interior of the boiler extending from the uppermost heating section to the wall of the inner shell adjacent to and below the lower part of the stack outlet structure."

[3] Here reproduce Figure 3 from the Mandelburg Patent.

The difficulty and expense in the installation of boilers with oval shaped stack outlets were, perhaps, not so great that their avoidance could be classified as a major contribution to the heating industry. Their avoidance was desirable, however, which clearly appears from Columbia's own unsuccessful efforts to accomplish it, its adoption in 1953 of the circular stack outlet and its urgent insistence here that it has a right to continue to sell boilers incorporating substantially the improvement disclosed by Mandelburg. Columbia and one other manufacturer of boilers of the Stauffer design were the only manufacturers offering boilers with oval shaped stack outlets, and their modification of their design to facilitate installation and to reduce its cost would seem obviously desirable. Though the testimony indicates Columbia sought the solution of the problem, it did not find it for more than seventeen years and then only after the Mandelburg Patent had been issued. After Mandelburg pointed the way, the solution may seem simple and obvious, but it hardly can be said to have been obvious in a legal sense when Columbia's skilled craftsmen could not provide the answer, though the desirability of improvement had been recognized for many years. As Judge Sobeloff said in S. H. Kress & Company v. Aghnides, 4 Cir., 246 F. 2d 718:

> "The usual defense that the result would have been obvious to one skilled in the art cannot avail the defendant here. Obviousness does not mean that one skilled in the art can perceive the solution after it has been found and pointed out by someone else; the test of obviousness is as of an earlier time, when the search is on. * * *"

Numerous cases give expression to the principle. Goodyear Tire & Rubber Co., Inc. v. Ray-O-Vac, 321 U.S. 275, 64 S. Ct. 593, 88 L. Ed. 721; Merck & Co., Inc. v. Olin Mathieson Chemical Corporation, 4 Cir., 253 F. 2d 156; Otto v. Koppers Company, Inc., 4 Cir., 246 F. 2d 789; Emerson v. National Cylinder Gas Company, 1 Cir.,

251 F. 2d 152; Muench-Kreuger Candle Co. v. Wilson, 9 Cir., 246 F. 2d 624; L-O-F Glass Fibers Company v. Watson, D. C. Cir., 228 F. 2d 40.

Mandelburg was not the first to use dry baffles in boilers to direct the flow of the gases over and around wet baffles. O'Hara Patent No. 2,037,665 and an Austrian Patent No. 32864 both show an arrangement of elements or baffles containing water with dry baffles to direct and control the flow of gases around them, and in each instance some of the wet baffles were wholly or partially above the level of the stack outlet. The boilers disclosed by those patents are not of the Stauffer design. Even without the disclosures of those patents, the use of dry baffles to control the direction and flow of hot gases would seem perfectly obvious, but the problem arose here out of the Stauffer design, and Mandelburg's contribution was the conception that the efficiency of that design could be preserved while modifying it to accommodate a circular stack outlet by separating the rear of the uppermost wet baffle from the inner shell and lowering the bottom of the stack outlet into the space thus provided. Neither O'Hara nor the Austrian patent anticipated what Mandelburg did, for the baffle arrangements they discloses were not Stauffer's and they were not concerned with the solution of the problem which was peculiar to the Stauffer design.

The O'Hara and Austrian patents, and each of the other patents cited by the defendants, were considered by the Patent Office, a circumstance which reinforces the statutory presumption of validity. We said in Chesapeake & O. Ry. Co. v. Kaltenbach, 4 Cir., 95 F. 2d 801:

> "* * * A patent is prima facie valid (Parks v. Booth, 102 U.S. 96; 26 L. Ed. 54; Echnbeuter v. Holthaus, 105 U.S. 94, 26 L. Ed. 939), and the presumption of validity is strengthened where, as here, the principal references urged against the patent have been considered by the Patent Office. As we said in Gulf Smokeless Coal Company v. Sutton, Steele & Steele, 4

> Cir., 35 F. 2d 433, 437: 'Prior patents relied upon as anticipations were carefully considered [by the Patent Office], and numerous changes were made in the claims before the patents were finally issued. It is well settled that in such case the presumption of patentability arising from the issuance of the patent is greatly strengthened.' "

In this Court the defense of anticipation is principally bottomed upon a tubular boiler manufactured and sold by Columbia. Mandelburg was familiar with this boiler for he had bought and sold it during the years of his association with Columbia. This boiler, instead of the wet baffles of the Stauffer design, has nineteen tubes arranged in four rows with vertical and horizontal spacing between the tubes, so that the rising gases flow around the tubes through the spaces separating them. To prevent the flue gases from being drawn directly to the stack outlet at the rear of the boiler, a dry baffle was placed above the topmost row of tubes and, rearward of the tubes, was inclined downwardly and rearwardly to a connection with the inner shell of the boiler at a point below the stack outlet. This baffle served the office of diverting the flue gases, so that they passed around the tubes near the front of the heating space. The baffle was of such shape that the space above it, through which all flue gases had to be exhausted, had a vertical dimension less than that of the stack outlet, but Columbia, who manufactured the boiler and recognized the desirability of modifying its Stauffer design to permit a circular stack outlet, did not recognize the answer to its problem in its tubular boiler. What was not obvious to it during the many years during which the problem went unanswered, can hardly be said to have been obvious to Mandelburg so as to deprive him of reward for his contribution.

We do not think that Claim 1 of the Mandelburg Patent can be fairly said to read upon Columbia's tubular boiler. The Patent Office required Mandelburg to make an elec-

tion of the species to which his invention was applicable, and he elected the Stauffer design, in the light of which it seems plain that the language Claim 1 was directed exclusively to the Stauffer design with gases flowing in wide serpentine turns through the spaces between baffles rather than rising substantially vertically in undulating waves between spaced tubes. Moreover the office of Mandelburg's dry baffle was not to achieve a desired dispersion of the gases in the heating area, which the unmodified Stauffer design provided, but to create a space to permit an enlargement of the vertical dimension of the stack outlet. As we read Claim 1 it is fairly limited to Mandelburg's actual contribution and cannot reasonably be said to read upon Columbia's tubular boiler with its dry baffle serving the sole office of achieving a forward dispersion of the hot gases.

Holding as we do that the Mandelburg Patent No. 2,663,107 is valid, we reach the question of infringement.

The figure in footnote 3 shows Mandelburg's dry baffle inclined from the horizontal, and he prescribes in claim 1 "downwardly and rearwardly inclined baffle means." When Columbia first produced Stauffer designed boilers with a circular stack outlet in 1953, the dry baffle it employed was inclined in a plane similar to that in Mandelburg's patent drawings, and the boilers it produced until after the filing of the suit appear to be literal copies of the patent. After this suit was filed, however; Columbia, introduced a slight modification of its design and has since then produced what it calls its "L Series." In this series, the dry baffle is welded to the underside of the uppermost wet baffle and it extends rearwardly in a horizontal plane to the inner shell of the boiler, at a point immediately below the stack outlet. Columbia, therefore, contends that the dry baffle, itself, is not inclined downwardly and rearwardly. The additional space made available by Mandelburg's disclosure was carved out by the severance of the

rear portion of the uppermost wet baffle and since the claim required the stack opening to bridge spaces lying above and below the uppermost wet baffle, it is clear that the interposed dry baffle must be, in part at least, below the level of the underside of the uppermost wet baffle. It seems to us, however, to make no difference whether the dry baffle lies in one plane or two. A dry baffle extending from the top of the uppermost wet baffle would have to be inclined substantially from the horizontal to reach a point below the stack outlet, and such an arrangement would be a literal infringement. Precisely the same result is accomplished if the baffle be made angular by utilizing the rear plate of the wet baffle and a horizontally disposed dry baffle, for together they provide both downwardly and rearwardly inclined means. Traveling the two sides of a triangle seems obviously equivalent to passage along the hypotenuse. The dimensions in Columbia's "L Series" were such that the dry baffle could be attached in a horizontal plane directly to the bottom of the wet baffle without any downward extension of the rear plate of the wet baffle, but the flow of the gases is still controlled by downwardly and rearwardly inclined baffle means within the meaning of the claim. If, however, the "L Series" be regarded as outside the literal language of the claim, it is but slightly so. Granting the claim the narrowest range of equivalents compels the conclusion that there is infringement. Avoidance of literal imitation by a change so insubstantial should not defeat the patent. Graver Tank & Mfg. Co. v. Linde Air Products Co., 339 U.S. 605, 70 S. Ct. 854, 94 L. Ed. 1097.

Columbia contends, however, that its stack outlet does not bridge spaces above and below the uppermost heating section, it being apparent from its horizontally disposed dry baffle attached to the underside of the uppermost wet baffle, that the bottom of the stack outlet is at the same level as the bottom of the uppermost heating section. The term "bridging," however, does not require that the stack

outlet extend into the space in order to connect it with some other space.' So long as the stack outlet comes to, without overlapping the space, it bridges it within the meaning of the claim; just as a swing bridge reaches to, but does not overlap, a bank.

We think that, reasonably construed, claim 1 of the Mandelburg Patent reads upon both series of defendant's Stauffer boilers having circular stack outlets.

The District Judge, we think correctly, dismissed Columbia from the action for lack of venue under 28 USCA § 1400(b), leaving as the sole remaining defendant Columbia Boiler Co., Inc., a Virginia corporation, all of the stock of which is owned by Columbia's stockholders and which is extensively controlled by Columbia, or its stockholders, in Pottstown. Though there was advertising matter referring to the office of the Virginia corporation as a factory branch and Columbia's home office in Pottstown as its offices and factory, suggesting a unitary business, the operations of the two corporations were kept distinct and separate. The Virginia corporation was treated as a separate entity, though its policies and activities were directed from Pottstown. Columbia sold boilers to the Virginia corporation, which paid for them, usually promptly, and resold them to customers in Virginia. Columbia did not service boilers sold by the Virginia corporation to Virginia customers, and it can be held to have a regular and established place of business in Virginia only by treating the office of the Virginia corporation as Columbia's regular and established place of business.

Decision on the venue question is controlled by Cannon Manufacturing Co. v. Cudahy Packing Co., 267 U.S. 333, 45 S. Ct. 250, 69 L. Ed. 634. If the rule of that case unduly emphasizes the form in which related corporations cast their intercorporate transactions and minimizes the control exercised by the one of the other, the rule, nevertheless, is well established. See Harris v. Deere and Com-

pany, 4 Cir., 223 F. 2d 161; Berkman v. Ann Lewis Shops, Inc., 2 Cir., 246 F. 2d 44; 18 Fletcher, Cyclopedia Corporations, § 8773. As this Court observed in Harris v. Deere and Company, supra, we cannot change or modify the rule, for any possible reconsideration of its decisions is the province of the Supreme Court.

While the foregoing cases were not under the special patent venue section, the District Judge could hardly find that Columbia had a regular and established place of business in Virginia if he could not hold that it was doing business at all in Virginia.

Accordingly, the decision below will be affirmed in part, reversed in part and remanded for further proceedings consistent with this opinion.

Affirmed in part and reversed in part.

APPENDIX B

Findings of Fact and Conclusions of Law of the District Court

1. Plaintiff is a New York corporation engaged in the sale of domestic heating boilers.

2. Defendant, Columbia Boiler Company of Pottstown, Incorporated (Columbia-Pottstown) is a Pennsylvania corporation engaged in the manufacture and sale of domestic heating boilers having its principal place of business at Pottstown, Pennsylvania.

3. Defendant, Columbia Boiler Company, Incorporated (Columbia-Virginia) is a Virginia corporation engaged in selling boilers manufactured by defendant, Columbia-Pottstown, as well as other equipment.

4. Plaintiff alleges a cause of action against defendants for infringement of United States Letters Patent No.

2,633,107 which relates to an improvement in the construction of domestic boilers.

5. Defendants in their answers assert the usual defenses of non-infringement, invalidity and unenforceability and counterclaim for a declaratory judgment adjudging the patent invalid and not infringed and further allege causes of action for unfair competition.

6. Defendants offered no proof concerning the unfair competition allegations.

7. Plaintiff is and has been since February 8, 1954, the owner by assignment of said Letters Patent and all rights to recover for past infringements thereof.

8. The Court has jurisdiction of the subject matter of this suit and of the parties hereto.

9. In about 1937, Columbia-Pottstown's predecessor, Columbia Boiler Company, a partnership composed of Frank I. Boarman and Harry J. Loughney, began manufacturing domestic heating boilers which will be referred to as the Stauffer design. This boiler construction is represented by the drawing in U.S. Patent No. 2,119,606 (Ex. P3). This design provides a combustion chamber in which combustion gases are generated which flow upwardly through a zigzag serpentine passage defined by inwardly tapering baffles. The Stauffer boiler also has an outer shell. The space between the outer and inner shell is filled with water making the tapering baffles perform as water chambers or heating sections so that the water contained within them is heated by the flue gases that pass around and over them.

10. Benedict W. Mandelburg filed an application for patent on a heating boiler with vertical undulating flue on April 15, 1950, which issued as patent No. 2,633,107 on March 31, 1953. Only claim 1 of the patent is in issue.

11. Defendants are charged with infringing claim 1 of this patent which reads:

"1. A boiler construction comprising inner and outer shells spaced apart to provide a water space therebetween, said inner shell having substantially horizontally extending, water-carrying heating sections vertically spaced from one another and interconnected through said water space, said heating sections being arranged to provide for the normal serpentine flow of heating gases around and between the heating sections, a cylindrical integral stack outlet structure extending between the inner and outer shells and lying in an elevated location adjacent the uppermost heating section and bridging spaces lying above and below the uppermost heating section, and transversely extending, downwardly and rearwardly inclined baffle means in the interior of the boiler extending from the uppermost heating section to the wall of the inner shell adjacent to and below the lower part of the stack outlet structure."

12. Defendant Columbia Boiler Company of Pottstown and its predecessors have been manufacturing and selling tubular boilers as exemplified by Defendants' Exhibit D-36 since prior to 1947.

13. The boilers of Defendants' Exhibit D-36 fully anticipate claim 1 of the Mandelburg patent, No. 2,633,107.

14. The patentee Mandelburg, while his application was pending in the Patent Office, restricted the claims to include as an essential limitation that the stack outlet structure bridge spaces lying above and below the uppermost heating section.

15. The patentee Mandelburg, while his application was pending in the Patent Office restricted the claims to include as an essential limitation that the baffle means extending

from the uppermost heating section to the wall of the inner shell be "downwardly and rearwardly inclined."

16. The boilers of Columbia Boiler Company of Pottstown as exemplified by Exhibit D-32 do not come within the scope of claim 1 of the Mandelburg patent 2,633,107, as they do not have any stack outlet structure bridging spaces lying above and below their uppermost heating section.

17. The boilers of Columbia Boiler Company of Pottstown as exemplified by Exhibit D-33 do not come within the scope of claim 1 of the Mandelburg patent 2,633,107, as they do not have any stack outlet structure bridging spaces lying above and below their uppermost heating section.

18. The boilers of Columbia Boiler Company of Pottstown as exemplified by Exhibit D-32 do not infringe claim 1 of the Mandelburg patent No. 2,633,107, because they do not have any downwardly and rearwardly inclined baffle means in the interior of the boiler extending from the uppermost heating section to the wall of the boiler adjacent to and below the lower part of the stack outlet structure.

19. The boilers of Columbia Boiler Company of Pottstown as exemplified by Exhibit D-33 do not infringe claim 1 of the Mandelburg patent No. 2,633,107, because they do not have any downwardly and rearwardly inclined baffle means in the interior of the boiler extending from the uppermost heating section to the wall of the boiler adjacent to and below the lower part of the stack outlet structure.

Conclusions of Law

1. Defendant, Columbia Boiler Company of Pottstown is not a proper party to the suit for lack of venue.

2. Claim 1 of the Mandelburg patent No. 2,633,107 is invalid in view of the prior art:

3. Claim 1 of the Mandelburg patent No. 2,633,107 is invalid in view of the prior public use and sale of Columbia tubular boilers.

4. Defendants do not infringe claim 1 of the Mandelburg patent No. 2,633,107.

(Sgd.) STERLING HUTCHESON,
United States District Judge.

July 22, 1958.

APPENDIX C

Patent Act of 1952. § 1. 66 Stat. 813. 35 U.S.C. §§ 1-293

. . . . . .

§ 103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made. July 19, 1952, c. 950, § 1, 66 Stat. 798.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1959

No. 428

COLUMBIA BOILER CO., INC.,

Petitioner,

vs.

MANVILLE BOILER CO., INC.,

Respondent.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

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Respondent.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

Respondent respectfully prays that the issuance of a writ of certiorari to review the judgment in the above-entitled action of the United States Court of Appeals for the Fourth Circuit be denied.

Opinions Below

The opinion of the Court of Appeals for the Fourth Circuit is reported at 122 USPQ 545 and appears as Appendix A of Petitioner's brief. The District Court did not hand down an opinion, but made findings of fact and conclusions of law, which appear as Appendix B of Petitioner's brief.

Jurisdiction

The judgment of the Court of Appeals was entered on July 25, 1959. The jurisdiction of this Court is invoked under 28 U. S. C., Sec. 1254(1).

Statute Involved

Section 103 of the Patent Act of 1952, 66 Stat. 792-814, 35 U. S. C., Secs. 1-293, which is involved here, is printed in Appendix C to Petitioner's brief.

Question Presented

Respondent is dissatisfied with Petitioner's presentment of the "Questions Presented". The actual and only question that could be presented to this Court is the correctness of the decision of the Court of Appeals upon the facts of record in this patent infringement action. This is an ordinary patent case involving no conflict of decisions between different Courts of Appeals, no new or doubtful question of law, no conflict between the decision of the Court of Appeals and the applicable decisions of this Court or any other court, and no matter of public interest or importance.

Petitioner phrases the questions presented to encompass the broad question of what is the standard of invention under the Patent Act of 1952. Respondent will be the first to agree that this question has been raised by many Courts of Appeals in recent years, but wishes to point out that the Court of Appeals for Fourth Circuit was not required to face this issue in the present case. The Court of Appeals determined the issue of patentability based on the particular facts in the record before it. Since the Court of Appeals' opinion lacks any comment on the present standard of invention, logic and reason requires this Court to treat the decision as holding that all tests of invention were met.

Statement

The present case involves a routine patent infringement suit. Respondent brought suit against the Petitioner for infringement of United States Letters Patent No. 2,633,197

in the District Court for Eastern District of Virginia. The District Judge held the patent invalid and non-infringed. The Court of Appeals reversed this holding in a well-reasoned opinion reported at 122 USPQ 545. The Court of Appeals stated:

> "• • • The baffle was of such shape that the space above it, through which all flue gases had to be exhausted, and a vertical dimension less than that of the stack outlet, but Columbia, who manufactured the boiler and recognized the desirability of modifying its Stauffer design to permit a circular stack outlet, did not recognize the answer to its problem in its tubular boiler. What was not obvious to it during the many years during which the problem went unanswered, can hardly be said to have been obvious to Mandelburg so as to deprive him of reward for his contribution."

As Petitioner points out, the Court of Appeals did take a different view of Mandelburg's invention from that of the District Court, however, respondent submits that correction of erroneous conclusions of law and fact are not only within the province of the Courts of Appeals but indeed it was the primary purpose for their establishment. This proper exercise of their power is not a reason for review by this Court.

ARGUMENT

1. The Petition fails to state any reason for Supreme Court review of this case not equally applicable to every patent infringement action in which a Court of Appeals reverses a District Court to sustain the patent in suit. Respondent knows of no facet of fact or law involved that makes this other than an ordinary patent infringement case.

An analysis of progress of the present litigation reveals nothing more than a routine patent infringement action.

The case was presented to the trial court in a full and complete manner. District Court Judge Hatcheson found that Mandelburg's contribution to the domestic boiler art was not patentable and that Columbia did not infringe. The Court of Appeals with the benefit of a full and adequate record of the proceedings below and well aware of the provisions of Rule 52(a) of the Federal Rules of Civil Procedure reversed these findings.

The real issue in this case has been the application of 35 U. S. C., § 103 to the facts. Petitioner's *only* reasons for urging the granting of certiorari is that it wishes this Court to interpret this section of the Patent Act. Respondent is the first to agree that the question of patentability holds academic interest for all persons connected with our patent system. Since *Hotchkiss* v. *Greenwood*, 57 U. S. 248 (1851); *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84 (1941) and *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147 (1950) and now since the Patent Act of 1952, the question of changes in the standard of patentability have continued to stimulate much discussion among the patent bar. The issue of patentability in patent law like the issue of negligence in tort law is a concept incapable of clear delineation. As Judge Learned Hand's statement in *Lyon* v. *Bausch & Lomb Optical Co.*, 244 F. 2d 530 (2 Cir. 1955), the case Petitioner and others have cited so much in seeking the review of patent cases, perceptively and eloquently described this problem. He said at 537:

> "Such judicial attitudes are indeed the stuff of which much of the law is made;"

After each decision of this Court, the old question is always reposed. "Has the standard of invention been changed?" To answer this question every time it is asked would require this Court to review scores of patent infringement cases every Term.

2. The Court of Appeals' decision indicates that Mandelburg's invention meets *all* standards of invention and thus renders moot the determination of a proper standard for further application to the facts in this case.

Unlike many of other Courts of Appeals, the Fourth Circuit Court of Appeals in this case decided the question of patentability without reference to any possible change or present duality of patentable standards. *R. M. Palmer Co. v. Luden's Inc.*, 236 F. 2d 496 (3 Cir. 1956); *Fisch v. Gould*, 246 F. 2d 5 (3 Cir. 1957); *Steffan v. Weber Heating and Sheet Metal Company*, 237 F. 2d 601 (8 Cir. 1959).

The Court of Appeals stated, based on the record before it, that "What was not obvious to it [Columbia] during the many years during which the problem went unanswered, can hardly be said to have been obvious to Mandelburg." [Bracketed word added.] There is no factual basis for overturning the Court of Appeals' decision on the *basis of the application of an incorrect standard of invention.* The record before the Court of Appeals adequately supports its decision. Admittedly judges may differ in their opinion of the evidence but this Court should not review a case in order to substitute its opinion or "judicial attitude" for that of the lower court.

There is no special or important reason for granting an issuance of a writ of certiorari in this case.

CONCLUSION

The petition for writ of certiorari should be denied.

Respectfully submitted,

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IN THE

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OCTOBER TERM, 1959

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v.

MANVILLE BOILER CO., INC., *Respondent*.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Fourth Circuit

REPLY BRIEF OF PETITIONER

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---

REPLY BRIEF OF PETITIONER

Respondent's brief correctly states that there is no conflict of decisions between different Courts of Appeals on the facts of record in this case, but mistakenly asserts that the only question that "could" be presented to this Court is the correctness of the decision below upon these facts. As this Court replied to essen-

tially the same argument in *A. & P. Tea Co.* v. *Supermarket Corp.*, 340 U. S. 147, at pages 153 and 154:

> "The questions of general importance considered here are not contingent upon resolving conflicting testimony * * *. The defect that we find in this judgment is that a standard of invention appears to have been used that is less exacting than that required * * *".

The question raised in the present case (and also in *Stoffel Seals Corporation* v. *E. J. Brooks Co.*, No. 361, and *Bernard Glagovsky* v. *Bowcraft Trimming Co. et al.*, No. 369) is a similar question of general importance:

> **was the standard of invention, as established by decisions of this Court, changed by the Patent Act of 1952?**

Obviously this question requires only one answer by this Court, not "scores" of answers "every Term" as implied by Respondent's Brief, page 4.

Respondent states (Respondent's Brief, page 2) that the decision below involves "no new or doubtful question of law" and "no matter of public interest or importance," since it merely determined the issue of patentability based on the particular facts in the record. But a necessary part of that determination was the application of a standard of invention. Respondent freely admits (Respondent's Brief, page 2) that "many Courts of Appeals" have raised the question of "*what is the standard of invention*" under the 1952 Patent Act, and that this question has stimulated much discussion among the patent bar. This doubtful question of law is of "general importance" now for the same reasons that it was in the *A. & P. case*, *supra*.

Conflict between the Circuits as to this question is clearly shown by comparison of the decisions below in the present case and in *Glagovsky* v. *Bowcraft* (No. 369). In the latter case, there had been a long delay in the face of need and plaintiff had solved the problem—

> "by *adopting* a device which, with only a mechanic's changes, had long been *in use in allied arts* * * *."[1] (Emphasis supplied)

In the present case, the Court also found there had been a long delay in the face of need and that plaintiff had solved the problem by the *adoption* and use in a Stauffer boiler of a baffle arrangement long known and *used in tubular boilers*.[2]

Diametrically opposite conclusions were reached in the above parallel situations, because *different standards of invention were applied*. In holding the Glagovsky patent *invalid* (No. 369), the First Circuit expressly declined to reconsider its previous statement that the 1952 Patent Act "merely codified the existing decisional law". In holding the Mandelburg patent *valid* in the present case, the Fourth Circuit obviously applied what it had previously called

> "the standard of invention by the accepted tests, as explained in Lyon v. Bausch & Lomb Optical Co., 2 Cir., 224 F. 2d 530."[3]

---

[1] See appendix to Petition in Glagovsky v. Bowcraft, No. 369, page 22.

[2] See quotation on page 3 of Respondent's Brief and also page 7a of the Petition in the instant case.

[3] See pages 6 and 8 of the Petition in the instant case.

Since the petition in the present case was filed, moreover, the Second Circuit has again disagreed within itself as to what is the proper standard of invention, just as it did in the *Stoffel Seals case* (see Petition for Certiorari No. 361). In *Tatko Brothers Slate Co., Inc.* v. *Hannon*, decided Sept. 11, 1959 and reported at 122 USPQ 585, the majority (Judges Clark and Hincks) reversed the District Court and held the patent in suit invalid for lack of invention. But Judge Madden (United States Court of Claims, sitting by designation) dissented, saying (122 USPQ 588):

> "The case seems to me to be getting itself decided, not on the basis provided by precedent and recent statute, of obviousness to those in the industry, but of obviousness to the judges after the patent has disclosed the device and the industry has adopted it. This seems to me to be a failure by the Court to adjust *itself to the purpose and spirit, the 'mood'*, see Universal Camera Corp. v. Labor Board, 340 U.S. 474, 487, of Section 103 of Title 35, United States Code, enacted in 1952." (Emphasis supplied)

CONCLUSION

The present uncertainty and confusion will continue until this Court defines the "mood" of Section 103 as to the standard of invention to be applied. Petitioner submits that there is ample evidence of doubt and conflict of opinion as to this question, throughout the lower courts, the bar, and the public at large, to warrant its immediate review and answer by this Court.

The Petition should be allowed.

Respectfully submitted.

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